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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/667,641

09/22/2003

Folkert W. Horst

1112

140

7590

11/03/2006

LADAS & PARRY  
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NEW YORK, NY 10023

EXAMINER

NGUYEN, CUONG H

ART UNIT

PAPER NUMBER

3661

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/667,641	Applicant(s) HORST ET AL.	
	Examiner CUONG H. NGUYEN	Art Unit 3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### *Response*

1. The examiner has an apology while grouping claims; because dependent claims 36-37 are dependent on claim 1 (a correction should be made in these claims' preamble because claim 1 is directed to a device), these claims should be grouped as shown below. To answer the argument on page 3, 4<sup>th</sup> para. "transmission unit" or "transmission means" is not necessary for "generating an RF transmission". On page 4, last para. the applicants argue about "switchyard operational setting", the examiner submits that only command/control signals are transmitted, not necessary in a switchyard environment (because this is not important). On page 5, 4<sup>th</sup> para. The applicants argue that "There is absolutely no mention in claim 38 that the claimed apparatus comprises a remote control device or an onboard receiver" the applicants are correct – because of lacking those components, claim 38 has a broader interpretation and falling into a different species (species IV). On page 6, 1<sup>st</sup> para. applicants request the examiner to retract "an improper statement"; however, current claimed language make pending claims are not patentable.

### *Election/Restrictions*

2. The current examiner respectfully submits that there is a restriction on patentably distinct species from the applicant's claims, as shown below:

- Species I: according to claims 1-10, and claims 20-27, 29, 31, 36-37 these claims are directed to a device to receive signals from a remote controller, without claiming a transmitter (i.e., "a remote on-board receiver" to accept remote signals), US classification 340/825.22.
- Species II: according to claims 11-19, these claims are directed to a locomotive control device/receiver, US classification 340/825.69, 825.72

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- Species III: according to claims 30, 32-35 these claims are directed to an apparatus for configuring a receiver (of a remote control) according to transmitted command signals, US classification 341/173, 176.
- Species IV: according to claims 28, and 38 these claims are directed to an apparatus including both a locomotive remote controller, a remote control device/transmitter and a on-board receiver, US classification 246/2R

3. According to the examiner's interpretation of pending generic claims, pending claims are not patentable because the applicants claim well-known subject matters.

Furthermore, please consider an example of claiming a remote control (for a TV), or a remote-control receiver, or a whole TV set (with a remote control, and a signal – receiver mounted on a TV - See 806.04(c) for Subcombination Not Generic to Combination

The situation is frequently presented where two different combinations are disclosed, having a subcombination common to each. It is frequently puzzling to determine whether a claim readable on two different combinations is generic thereto. This was recognized in Ex parte Smith, 1888 C.D. 131, 44 O.G.1183 (Comm'r Pat.1888), where it was held that a subcombination was not generic to the different combinations in which it was used. To exemplify, a claim that defines only the subcombination, e.g., the use of a remote control transmitter for locomotive and a receiver on an on-board locomotive to receive that transmitted signal, and an apparatus to transmit signals to a remote control device, is not a generic or genus claim to three different combinations.

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Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.


Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 9:30 am - 5:30 pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3661